

REMARKS

Claim Rejections -- 35 USC § 103

Claims 25-32 are rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 5,827, 494 to Yano ("Yano") in view of U.S. Patent No. 4,297,249 to Przybyla ("Przybyla") and claims 32-40 are rejected under 35 USC 103(a) as being unpatentable over Yano in view of Przybyla, and further in view of U.S. Patent No. 4,146,685 to Tucholski ("Tucholski") and U.S. Patent No. 5,688,616 to Yamawaki ("Yamawaki"). Applicant traverses these rejections because the examiner has not established a *prima facie* case of obviousness for the reasons set forth below and the rejections are improper and shown be withdrawn.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, and the prior art reference must teach or suggest all the claim limitations. *See MPEP. § 2143*. In the present case, the examiner has not shown that the prior art teaches or suggests all of the claim limitations and therefore the rejection is improper and should be withdrawn.

Yano and Przybyla

The examiner has rejected claims 25-32 as being unpatentable over the combination of Yano and Przybyla. However, neither Yano or Przybyla discloses a zinc anode composition that has electrochemically active form of zinc where the zinc anode can be repeatedly cycled between an oxidized and reduced state as happens with an anode. (*See Paragraphs 0002 and 0081 of the corresponding published application and Example 1.*) The purpose of the claimed zinc anode composition is to reduce shape change and zinc dendrite growth which are problems unique to zinc anodes. (*See paragraphs 0008 and 0009 of the published application*)

Yano is directed to a nickel electrode (*see Yano, col. 5, line 48*) and not to a zinc anode as claimed and does not disclose that the nickel electrode has an electrochemically active form of zinc.

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Przybyla is directed to preparing a silver oxide electrode to produce a cathode of a galvanic cell (*See Przybyla, claim 1*). Thus, neither Yano or Przybyla teaches or suggests a zinc anode composition that has electrochemically active form of zinc where the zinc anode can be repeatedly cycled between an oxidized and reduced state. Therefore, the examiner has not established a prima facie case of obviousness and the obviousness rejection based on Yano and Przybyla must be withdrawn.

Yano, Przybyla, Tucholski and Yamawaki

Tucholski and Yamawaki (the other prior art relied on by the examiner) do not cure the deficiencies (no teaching or suggestion of a claim element) noted above for Yano and Przybyla. Therefore, claims 32-40 are also allowable over the prior art and should be allowed.

Conclusion

Based on the above, Claims 25 -26, and 28-40 are now in condition for allowance. Please feel free to contact the undersigned attorney at (650) 833-2055 if a telephone conversation would be useful to expedite the prosecution of this case.

The Commissioner is authorized to charge any additional fees which may be required, including petition fees and extension of time fees to Deposit Account **No. 07-1896** referencing Docket No. 358261-991100 (formerly 1772-000002).

Respectfully submitted,

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